

Remarks

In the Office Action mailed on October 10, 2006 (hereinafter the "Office Action"), claims 1-2, 5-9, 11-13, and 19-21 were rejected as unpatentable over U.S. Pat. Pub. No. 2003/0039242 ("Moore") in view of U.S. Pat. Pub. No. 2004/0066776 ("Ishidoshiro") and U.S. Pat. Pub. No. 2004/0218575 ("Ibe"). Claims 8-13 and 21 have been canceled without prejudice or disclaimer. Applicants respectfully traverse the remaining rejections.

Independent claim 1 recites sending a call forwarding message including an internet protocol address associated with a wireless local area network base station from a mobile phone to a remote cellular network element of a wide area cellular network. The Office Action acknowledges that Moore does not disclose sending a call forwarding message including an internet protocol address associated with a wireless local area network base station from a mobile phone to a remote cellular network element of a wide area cellular network. *Office Action*, p. 3.

The Office Action states that Ishidoshiro discloses "sending a message which includes the internet protocol address from the mobile phone to a remote cellular network element of a wide area cellular network (i.e., the radio IP telephone set notifies the wireless LAN base station of a terminal ID, which includes IP address, a MAC address, and a telephone number. The wireless LAN base station sends the terminal ID to the gatekeeper) (see pages 3-4, paragraphs 38-40)." *Office Action*, p. 3 (emphasis added). Claim 1 recites sending a call forwarding message including an internet protocol address associated with a wireless local area network base station from a mobile phone to a remote cellular network element of a wide area cellular network. Applicants respectfully submit that the wireless LAN base station sending a terminal ID to a gatekeeper does not disclose or suggest sending a call forwarding message from a mobile phone to a remote cellular network element.

The Office Action states that Ibe discloses that to initiate handoff from the WLAN to the WWAN, the mobile device sends an 'initiate handoff' message to the Cellular Controller via Handoff Controller when the received signal strength indicator goes below a predefined threshold. *Office Action*, p. 4. Applicants respectfully submit that the Cellular Controller is not a remote cellular network element of a wide area cellular network, as recited in claim 1. Rather, the Cellular Controller is an element of the WLAN. For example, the Cellular Controller resides

within the corporate LAN as shown in Figure 1. *Ibe*, Figure 1. Further, *Ibe* states that it “performs dynamic data handoff and does not require changes in the carrier’s network architecture.” *Ibe*, p. 2, paragraph 24. Hence *Ibe* teaches away from adding a Cellular Controller as a remote cellular network element of a wide area cellular network. Therefore, *Ibe* does not disclose or suggest sending a call forwarding message including an internet protocol address from the mobile phone to a remote cellular network element of a wide area cellular network, as recited in claim 1.

The Office Action also fails to establish a *prima facie* case of obviousness with regard to claim 1 because there is no motivation to make the asserted combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added). The Office Action states as its rationale for making the combination “to ensure proper access to the network.” *Office Action*, p.4. Moore discloses ensuring proper access to a network at paragraph [0044]. Ishidoshiro discloses ensuring proper access to a network at paragraphs [0009] and [0010]. *Ibe* discloses ensuring proper access to a network at paragraph [0038]. Logically, a feature already included in each reference could not motivate combining the references because each reference standing alone already includes the feature. Thus, the Office Action fails to establish a *prima facie* case of obviousness for at least this additional reason. Claim 1 is therefore allowable.

The combination of Moore, Ishidoshiro and *Ibe* does not disclose or suggest each element of claim 1, and there is no motivation to combine the references. The Office Action, therefore, fails to establish a *prima facie* case of obviousness with regard to claim 1. Additionally, since claims 2, 5-7 and 19-20 depend from claim 1, the combination of Moore, Ishidoshiro and *Ibe* does not disclose or suggest each element of claims 2, 5-7 and 19-20. Claims 1-2, 5-7, and 19-20 are therefore allowable.

Claim 3 stands rejected as being unpatentable over the combination of Moore, *Ibe* and Ishidoshiro in further view of U.S. Pat. Pub. No. 2004/0213212 (“Reding”). Claim 3 depends from claim 1. As discussed above, the combination of Moore, *Ibe* and Ishidoshiro does not disclose or suggest each feature of claim 1, and is improper because there is no motivation to make the combination. For example, the combination of Moore, *Ibe* and Ishidoshiro does not

disclose or suggest sending a call forwarding message including an internet protocol address associated with a wireless local area network base station from a mobile phone to a remote cellular network element of a wide area cellular network, as recited in claim 1. Reding discloses a method of managing calls including receiving user-defined preferences regarding handling of calls directed to at least one of the devices, receiving an indication regarding wireless communications between a first device and a second device, and modifying the handling of calls to the one or more communications devices in response to receipt of the indication. *Reding*, paragraph [0007]. However, Reding does not disclose or suggest sending a call forwarding message including an internet protocol address associated with a wireless local area network base station from a mobile phone to a remote cellular network element of a wide area cellular network, as recited in claim 1. Since claim 3 depends from claim 1, and the asserted combination does not disclose or suggest each feature of claim 1, the asserted combination also does not disclose or suggest each feature of claim 3. Claim 3 is therefore allowable.

Claim 4 stands rejected as being unpatentable over the combination of Moore, Ibe and Ishidoshiro in further view of U.S. Pat. Pub. No. 2004/0127241 ("Shostak"). Claim 4 depends from claim 1. As discussed above, the combination of Moore, Ibe and Ishidoshiro does not disclose or suggest each feature of claim 1, and is improper because there is no motivation to make the combination. For example, the combination of Moore, Ibe and Ishidoshiro does not disclose or suggest sending a call forwarding message including an internet protocol address associated with a wireless local area network base station from a mobile phone to a remote cellular network element of a wide area cellular network, as recited in claim 1. Shostak discloses a system employing personal badges to allow a user to initiate and receive calls over a network. *Shostak*, Abstract. However, Shostak does not disclose or suggest sending a call forwarding message including an internet protocol address associated with a wireless local area network base station from a mobile phone to a remote cellular network element of a wide area cellular network, as recited in claim 1. Since claim 4 depends from claim 1, and the asserted combination does not disclose or suggest each feature of claim 1, the asserted combination also does not disclose or suggest each feature of claim 4. Claim 4 is therefore allowable.

Claim 14 stands rejected as being unpatentable over the combination of Reding, Moore, Ibe and Ishidoshiro. *Office Action*, p. 13. Claim 14 recites a mobile phone device comprising a wide area cellular communication module that formulates a call forwarding message that includes the internet protocol address, the call forwarding message to be communicated to the remote wide area cellular network. The combination of Reding, Moore, Ishidoshiro and Ibe does not disclose or suggest this feature.

The Office Action admits that Reding does not disclose this element of claim 14. *Office Action*, p. 14. The Office Action asserts that Moore discloses:

[R]eceiving an internet protocol address (see page 2, paragraph 32, and page 3 paragraph 39-40), and sending a call forwarding message from the mobile phone to a remote wide area cellular network (i.e., the handset 10 may first request the telephone number of the VoIP gateway 20, and then send a command to the mobile telephone network 30 instructing the mobile telephone network to forward incoming telephone calls to a telephone number of the VoIP gateway 20 via the VoIP telephone network 25) ((see paragraphs 32, 34 and 39). As known, for the call to be properly forwarded, the network would receive the IP address with the forwarding message, and sending a call forwarding message from the mobile phone to a remote cellular network element of a wide area cellular network.

Office Action, p. 14 (first emphasis in original, second emphasis added).

As the Office Action acknowledges, Moore discloses sending a call forwarding instruction to a mobile telephone network instructing the mobile telephone network to forward incoming telephone calls to a telephone number. *Id.* In contrast, claim 14 recites a call forwarding message that includes an internet protocol address received from a wireless local area network. Moore does not disclose this feature of claim 14. Further, the Office Action appears to imply that the forwarding instruction of Moore would inherently include an IP address. *Id.* A claim element is inherently described in a reference if it is necessarily present, and not merely probably or possibly present. *See Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 68 USPQ2d 1186 (Fed. Cir. 2003). Applicants respectfully submit that an IP address is not necessarily present in a call forwarding instruction.

The Office Action asserts that Ishidoshiro, at page 3-4, paragraphs 38-40, discloses a handset wherein a message is formulated that includes the internet protocol address, the call forwarding message to be communicated to a network. *Office Action*, p. 15. Applicants respectfully disagree. Ishidoshiro discloses a base station sending a terminal ID and a base station ID to a gatekeeper. *Ishidoshiro*, p. 3, paragraph [0038]. The base station receives the terminal ID from the radio IP telephone set; therefore, the base station must formulate the message to the gatekeeper that included the terminal ID and the base station ID. Thus, the radio IP handset of Ishidoshiro does not disclose or suggest a mobile phone device comprising a wide area cellular communication module that formulates a call forwarding message that includes the internet protocol address, as recited in claim 14.

The Office Action asserts that:

Ibe discloses that to initiate the handoff from the WLAN to the WWAN, the mobile device sends an "initiate handoff" message to the Cellular controller via Handoff Controller when the received signal strength indicator goes below a predefined threshold. Included in this message are the parameters of the current TCP connection: its port number, window size, and its IP address in the WLAN (see abstract and paragraph 46).

Office Action, p. 15

As the Office Action acknowledges, Ibe discloses that the mobile device sends a handoff message to the Cellular Controller. Applicants respectfully submit that the handoff message of Ibe is not a call forwarding instruction. Call forwarding is a redirection feature. *See e.g.*, en.wikipedia.org/wiki/Call_forwarding. Handoff is a process of transferring an ongoing call or data session from one channel connected to the core network to another. *See, e.g.*, en.wikipedia.org/wiki/Handoff. Thus, the handoff message sent by the mobile phone of Ibe is not a call forwarding message. Further, as previously discussed, the Cellular Controller of Ibe is an element of the local network rather than an element of the remote wide area cellular network, as recited in claim 14.

The Office Action also fails to establish a *prima facie* case of obviousness with regard to claim 14 because there is no motivation to make the asserted combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious

unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added). The Office Action states as its rationale for making the combination “to insure the authentication of the communication process.” *Office Action*, p.15. Reding discloses authenticating the communication process at paragraph [0041]. Moore discloses authenticating the communication process at paragraph [0042]. Authentication is inherent in Ishidoshiro because the 802.11b standard recited in paragraph [0030] provides authentication of devices attached to LAN ports. *See, e.g.,* en.wikipedia.org/wiki/IEEE_802.1X. Ibe discloses authenticating the communication process at paragraph [0018]. Logically, a feature already included in each reference could not motivate combining the references because each reference standing alone already includes the feature. Thus, the Office Action fails to establish a *prima facie* case of obviousness for at least this additional reason. Claim 14 is therefore allowable.

Claims 15 and 18 depend from claim 14 and are also allowable at least by virtue of their dependence from allowable claim 14.

Conclusion

Any changes to the claims in this amendment, which have not been specifically noted to overcome a rejection based upon cited references, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto. Applicants’ failure to challenge any cited reference as prior art should not be construed as an admission by Applicants that the unchallenged reference does constitute prior art.

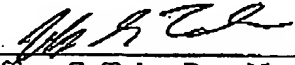
Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the rejections, as well as an indication of the allowability of each of the pending claims.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

Applicants do not believe that any additional fees are due at this time. However, if it is determined that additional fees are required, the Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

12-19-2006
Date


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicant
TOLER SCHAFFER, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone)
(512) 327-5575 (fax)